

REMARKS

Claims 1-46 are currently pending, although claims 44-46 have been withdrawn from consideration. Upon indication of allowable subject matter, Applicants respectfully request rejoinder of claims 44-46, which depend from claim 1, pursuant to MPEP § 821.04.

The Office Action rejected claims 1-43 under 35 U.S.C. § 103 as obvious over U.S. patent 5,556,615 (“Janchitraponvej”) in view of U.S. patent 4,390,522 (“Jacquet”), U.S. patent 6,214,326 (“Dupuis”) and U.S. patent 6,224,888 (“Vatter”). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

The claimed invention relates to compositions containing at least one silicone with quaternary ammonium groups and at least one liquid fatty alcohol. As explained in the Background section of the present application, this unique combination of elements provides, among other things, transparent compositions with good hair conditioning properties despite the fact that such compositions contain liquid fatty alcohol. Such unique compositions are neither taught nor suggested by the prior art.

Initially, Applicants note that no *prima facie* case of obviousness has been set forth by the Office Action. For example, no motivation would have existed to combine Janchitraponvej with any of the other cited references to yield the claimed invention. Specifically, as the Office Action has recognized (at page 9), Janchitraponvej does not teach or suggest adding a liquid fatty alcohol to his compositions. Moreover, because (1) Janchitraponvej was seeking to produce “clear” compositions (see, for example, col. 1, line 12); and (2) conventional compositions containing liquid fatty alcohols were not transparent (see, specification at page 2, lines 4-6; see also, Comparative Example 2 in the Rule 132 declaration discussed below), no motivation would have existed to add liquid fatty alcohols to

Janchitraponvej's compositions: such combination would have been expected to result in a non-transparent composition which was contrary to Janchitraponvej's purpose. Under such circumstances, no motivation could have existed to add liquid fatty alcohol to Janchitraponvej's compositions. See MPEP § 2143.01.

Applicants respectfully submit that for at least this reason no *prima facie* case of obviousness has been set forth.

Furthermore, even assuming a *prima facie* case of obviousness has been set forth -- which is not the case -- sufficient evidence of unexpected/surprising results exists to rebut any such hypothetical case of obviousness. More specifically, submitted concurrently herewith is a Rule 132 declaration demonstrating the unexpected/surprising results associated with the claimed compositions.

In the Declaration, an Invention Composition containing isostearyl alcohol, a liquid alcohol, and a silicone with quaternary ammonium groups was prepared, and Comparative Composition 1 which did not contain a liquid alcohol, but rather contained stearyl alcohol, a solid alcohol, and Comparative Composition 2 which did not contain a silicone with quaternary ammonium groups, but rather a primary silicone amine compound (amodimethicone), were also prepared. (Rule 132 dec., par. 3).

The turbidity of these three compositions was then determined and compared. The Invention Composition was translucent, having a turbidity of 74 NTU, while both of the Comparative Compositions were more opaque, having a turbidity of greater than, respectively, 150 and 1000 NTU. (Rule 132 dec., par. 4).

Sensory characteristics associated with these compositions were also determined and compared. When comparing the smoothness properties associated with the Invention Composition to those associated with Comparative Composition 1, the Invention Composition received an average score of 3.7, while Comparative Composition 1 received an average score of 3.4. (Rule 132 dec., par. 6). When comparing the smoothness properties associated with the Invention Composition to those associated with Comparative Composition 2, the Invention Composition received an average score of 3.8, while Comparative Composition 2 received an average score of 3.2. (Rule 132 dec., par. 7). This difference in smoothness was significant, and demonstrates that the Invention Composition provides hair with significantly better smoothness properties than Comparative Compositions 1 and 2. (Rule 132 dec., pars. 6 and 7).

Furthermore, when comparing the flexibility properties associated with the Invention Composition to those associated with Comparative Composition 2, the Invention Composition received an average score of 4.0, while Comparative Composition 2 received an average score of 3.6. (Rule 132 dec., par. 8). This difference in flexibility was significant, and demonstrates that the Invention Composition provides hair with significantly better smoothness properties than Comparative Composition 2. (Rule 132 dec., par. 8).

The vast difference in cosmetic properties (turbidity, flexibility and smoothness) between the Invention Composition and the Comparative Compositions was surprising and unexpected given the similarity of the compositions, and demonstrates the benefits of combining a liquid alcohol and a silicone with quaternary ammonium groups in a single composition. (Rule 132 dec., pars. 9 and 10).

The improved cosmetic properties associated with the invention compositions are commercially significant -- hair care compositions which make hair smoother and more flexible are more commercially viable than other compositions. (Rule 132 dec., par. 11). Also, because clear compositions are often perceived by consumers to be cleaner or more hygienic than opaque compositions, translucent compositions are more commercially viable than opaque compositions. (Rule 132 dec., par. 11).

Thus, the unique combination of elements required by the present invention results in compositions having improved sensory and transparency characteristics. Compositions which do not contain either the required silicone with quaternary ammonium groups or the required liquid fatty alcohol do not possess such improved transparency and sensory characteristics. Clearly, the improved compositions of the present invention are neither taught nor suggested by the cited art.

For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

The Office Action also rejected claims 1-35 and 37-43 under the judicially created doctrine of double patenting over claims 1-33 in U.S. patent application serial no. 10/608,264 in view of Jacquet. In view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

As explained above in connection with the § 103 rejection, no motivation would have existed to add a liquid fatty alcohol to compositions such as those disclosed in Janchitraponvej and those claimed in the '264 application. Thus, just as no *prima facie* case of obviousness exists, no supportable double patenting rejection has been set forth. At any

Application No. 10/606,786
Response to Office Action dated October 30, 2006

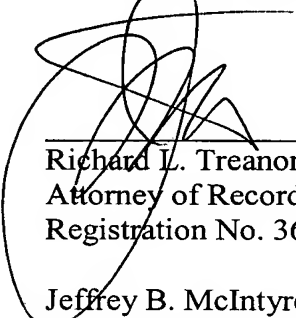
rate, the evidence demonstrating the unexpected/surprising results associated with the claimed invention is also sufficient to rebut the pending double patenting rejection.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the double patenting rejection.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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